

REMARKS

Claims 1-30 are pending in the present application. Claims 1, 8, 9, 11, 18, 19, 21, 28 and 29 are amended. Support for the amendments to independent claims 1, 11 and 21 may be found at least on page 3, lines 3-24 and on page 12, lines 10-32. Claims 9, 19 and 29 are amended to correct typographical errors and to clarify the claims. Support for the amendments to dependent claims 9, 19 and 29 may be found at least on page 24, line 22 through page 25, line 3. Claims 8, 18 and 28 are amended to provide antecedent basis and claim 28 is also amended for consistency with the instructions of claim 21. Reconsideration of the claims is respectfully requested.

Amendments are made to the "Related Application" section of the specification to enter the Application Serial Number for Attorney Docket Number AUS920010953US1. No new matter is added by any of the amendments to the specification.

I. Telephone Interview

Applicants thank Examiner George C. Neurauter for the courtesies extended to Applicants' representative during the April 7, 2005 telephone interview. During the interview, Applicants' representative discussed the distinctions between the claims and the cited references. The substance of the telephone interview is summarized in the following remarks.

II. Claim Objections

The Office Action objects to claims 9, 19 and 29 because of informalities. Claims 9, 19 and 29 are amended to add the word "and" to correct the typographical error in each of the claims as suggested by the Examiner. Therefore, the Applicants respectfully submit that the objection of claims 9, 19 and 29 has been overcome.

III. 35 U.S.C. § 102, Alleged Anticipation Based on *Donahue*

The Office Action rejects claims 1, 7, 8, 11, 17, 18, 21, 27 and 28 under 35 U.S.C. § 102(e) as being allegedly anticipated by *Donahue*, U.S. Patent Application Publication Number 2002/0004907 A1. This rejection is respectfully traversed.

As to independent claims 1, 11 and 21, the Office Action states:

Regarding claim 1, Donahue discloses a method of monitoring use of an instant messaging user account, comprising:

receiving an instant message (referred to within the reference as "chat session"; paragraph 0004);

storing a transcript ("log") of the instant message in a storage device (paragraph 0011);

analyzing ("processing") the transcript for occurrences of questionable content to thereby identify at least one portion of the transcript having questionable content; (paragraph 0015, 0016 and 0018) and

providing the at least one portion of the transcript to a designated monitor of the instant messaging user account ("user"). (paragraph 0006, last sentence) ...

Claims 11, 17, and 18 are rejected since these claims recite an apparatus that contain substantially the same limitations as recited in claims 1, 7, and 8 respectively.

Claims 21, 27, and 28 are rejected since these claims recite a computer program product that contain substantially the same limitations as recited in claims 1, 7, and 8 respectively.

Office Action dated January 21, 2005, pages 3-4.

As amended, claim 1, which is representative of the other rejected independent claims 11 and 21 with regard to similarly recited subject matter, reads as follows:

1. A method of monitoring use of an instant messaging source user account, comprising:

receiving an instant message from a destination user;

searching a registry that identifies a set of approved destination users to determine if a transcript of the received instant message is desired, wherein the transcript is not desired if the destination user is identified in the registry as being an approved destination user, and wherein the transcript is desired if the destination user is not identified in the registry as being an approved destination user;

storing the transcript of the received instant message in a storage device in response to determining that the transcript is desired;

analyzing the transcript for occurrences of questionable content to thereby identify at least one portion of the transcript having questionable content; and

providing the at least one portion of the transcript to a designated monitor of the instant messaging user account. (emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when

determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that *Donahue* does not identically show every element of the claimed invention arranged as they are in the claims. Specifically, *Donahue* does not teach or suggest searching a registry that identifies a set of approved destination users to determine if a transcript of the received instant message is desired, wherein the transcript is not desired if the destination user is identified in the registry as being an approved destination user, and wherein the transcript is desired if the destination user is not identified in the registry as being an approved destination user.

Donahue is directed to a system for monitoring and maintaining an acceptable use policy for network communications. The communications are monitored, stored and searched for the presence of pre-selected regular expressions, either by subject category or by keywords. The regular expressions within the subject categories are assigned predetermined values, either negative or positive. If a communication contains regular expressions whose sum of weighted values exceeds a threshold value, the communication is stored for subsequent review by an authorized user of the system. If the communication contains keywords selected by the authorized user, the communication is also stored for subsequent review. *Donahue* does not teach or suggest searching a registry that identifies a set of approved destination users to determine if a transcript of the received instant message is desired, wherein the transcript is not desired if the destination user is identified in the registry as being an approved destination user, and wherein the transcript is desired if the destination user is not identified in the registry as being an approved destination user, as recited in claims 1, 11 and 21.

The Office Action refers to the following portions of *Donahue* in the rejection of independent claims 1, 11 and 21:

[0006] The present invention utilizes a method of weighted regular expressions to perform language analysis, categorize the monitored data and report deviations from a company's acceptable use policy. The present invention monitors all Transport Control Protocol/Internet Protocol (TCP/IP) network communications. It is not limited to just web or email monitoring. It stores any TCP/IP sessions that match the criteria selected by the user from either predefined categories or user

defined keywords. The stored sessions can then be viewed, downloaded, and/or deleted by the user.

[0011] During monitoring and storing, the program listens to the Ethernet interface in promiscuous mode, storing each TCP/IP half-session to its own file or log on disk.

[0015] Each log, or independent portion of the log is then processed by the "categorize" subroutine which is illustrated in the flow diagram of FIG. 2. First, the data is stripped of any content which does not appear to contain language elements. The remainder, i.e., text containing language elements, is stored as a string of language elements separated by spaces. This allows the language elements or text to be effectively searched regardless of its original formatting. In example 1, addressed below, an email message is processed. Note that in email, quotation of prior email references are commonly preceded by numerous "greater than signs" (>), which are stripped in this step.

[0016] The text is then searched to determine whether it matches the current set of user-selected criteria. If so, the log is saved in a separate file system in one or more subdirectories based on which criteria were matched. Then the log is deleted.

[0018] This process is different from simple keyword matching in that many individual key phrases can be matched, without necessarily causing a match for the category. It also enables matching based on a sufficient amount of questionable language content, the constituent key phrases of which might be completely innocuous individually.

Donahue, paragraphs 6, 11, 15, 16 and 18.

These portions of *Donahue* only teach analyzing the language of monitored data from TCP/IP network communications. Any monitored data that matches criteria selected by a user from either predefined categories or user-defined keywords is stored. The stored data can then be viewed, downloaded, and/or deleted by the user. To the contrary, claims 1, 11 and 21 recite searching a registry that identifies a set of approved destination users to determine if a transcript of the received instant message is desired. A transcript is not desired if the destination user is identified in the registry as being an approved destination user and a transcript is desired if the destination user is not identified in the registry as being an approved destination user. *Donahue* does not teach or suggest this feature.

Additionally, in claims 1, 11 and 21, the storing of the transcript of the instant message in a storage device is in response to determining that the transcript is desired. The stored transcript is analyzed for occurrences of questionable content so that a designated monitor is made aware of the questionable content from instant messages between the instant messaging source user and a destination user. *Donahue* does not teach or suggest the features of claims 1, 11 and 21. To the contrary, *Donahue* teaches storing monitored data that matches predefined categories or user-defined keywords.

In view of the above, Applicants respectfully submit that *Donahue* does not teach each and every feature of independent claims 1, 11 and 21, as is required under 35 U.S.C. § 102(e). At least by virtue of their dependency on claims 1, 11 and 21, respectively, *Donahue* does not teach each and every feature of dependent claims 7-8, 17-18 and 27-28. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 7, 8, 11, 17, 18, 21, 27 and 28 under 35 U.S.C. § 102(e).

IV. 35 U.S.C. § 103, Alleged Obviousness Based on *Donahue*

The Office Action rejects claims 2-6, 10, 12-16, 20, 22-26 and 30 under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Donahue*. This rejection is respectfully traversed.

As discussed above, *Donahue* does not teach or suggest the features as recited in amended independent claims 1, 11 and 21. Therefore, *Donahue* does not teach or suggest the features of dependent claims 2-6, 10, 12-16, 20, 22-26 and 30 at least by virtue of their dependency on independent claims 1, 11 and 21, respectively. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-6, 10, 12-16, 20, 22-26 and 30 under 35 U.S.C. § 103(a).

In addition, with regard to claims 2, 12 and 22, *Donahue* does not teach or suggest that the method is implemented in an instant message service provider of a distributed data processing system. *Donahue* only teaches that a chat session may be monitored. With respect to claims 5, 15 and 25, *Donahue* does not teach or suggest providing the at least one portion of the transcript to a designated monitor includes transmitting the at least one portion of the transcript as an attachment to an electronic mail message. Additionally, *Donahue* does not teach or suggest that the electronic mail message is

transmitted in response to a request from the designated monitor, as recited in claims 6, 16 and 26. To the contrary, *Donahue* only teaches that an email message may contain multiple documents in the form of attachments and that these attachments may need to be converted to a format containing text and analyzed separately from the email.

Thus, in addition to being dependent on their respective independent claims, claims 2-6, 10, 12-16, 20, 22-26 and 30 are also distinguished over the *Donahue* reference based on the specific features recited therein.

V. 35 U.S.C. § 103, Alleged Obviousness Based on *Donahue* and *Fertell*

The Office Action rejects claims 9, 19 and 29 under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Donahue* in view of *Fertell et al.* (U.S. Patent Application Publication Number 2002/0032770), hereinafter referred to as *Fertell*. This rejection is respectfully traversed.

Since claims 9, 19 and 29 depend from independent claims 1, 11 and 21, respectively, the same distinctions between *Donahue* and the invention recited in claims 1, 11 and 21 apply to dependent claims 9, 19 and 29. In addition, *Fertell* does not provide for the deficiencies of *Donahue* with regard to independent claims 1, 11 and 21. *Fertell* is directed to a method of remotely monitoring an Internet session. *Fertell* is cited for allegedly disclosing an instant messaging account characteristic, which includes a date/time distribution of instant messages. *Fertell* does not teach or suggest searching a registry that identifies a set of approved destination users to determine if a transcript of the received instant message is desired, wherein the transcript is not desired if the destination user is identified in the registry as being an approved destination user, and wherein the transcript is desired if the destination user is not identified in the registry as being an approved destination user. Thus, any alleged combination of *Fertell* with *Donahue* still would not result in the invention recited in claims 1, 11 and 21 from which claims 9, 19 and 29 depend. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 9, 19 and 29 under 35 U.S.C. § 103(a).

In addition, with regard to amended claims 9, 19 and 29, *Donahue* and *Fertell*, taken alone or in combination, do not teach or suggest that the at least one instant messaging account characteristic includes at least one of a ranked list of user

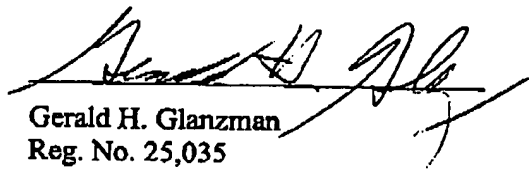
identifications for most frequent incoming instant messages, a ranked list of user identifications for most frequent outbound target user identifications, a ranked list of most frequent recent incoming or outbound user identifications, a date/time distribution of instant messages that provides contact patterns for a particular user identification, and tracking of the contact patterns for the particular user identification. The present invention, on page 24, line 22 through page 25, line 3, describes that the timestamps of each transcript record may be examined to determine at what times and days of the week that an instant messaging user account is being contacted by or is contacting a particular user identification. The cited portions of *Fertell* only teach that transferred data may include a time-stamp when it is stored on a remote computer. Further, *Donahue* and *Fertell* do not teach or suggest any of the instant messaging account characteristics as recited in amended claims 9, 19 and 29. Thus, in addition to being dependent on their respective independent claims, claims 9, 19 and 29 are also distinguished over the *Donahue* and *Fertell* references based on the specific features recited therein.

VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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